




PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) FUJIWARA=4														
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 14550, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____ Signature _____  Typed or printed name _____	Application Number 10/564,039	Filed January 10, 2006														
	First Named Inventor Makoto FUJIWARA et al															
	Art Unit 1621	Examiner Nizals Chandrakumar														
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/></td><td>applicant/inventor</td><td rowspan="2"></td><td>Signature</td></tr><tr><td><input type="checkbox"/></td><td>assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>Anne M. Kornbau Typed or Printed Name</td></tr><tr><td><input checked="" type="checkbox"/></td><td>attorney of record. Registration number 25,884</td><td>202-628-5197 Telephone number</td></tr><tr><td><input type="checkbox"/></td><td>attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td>August 7, 2008 Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/>	applicant/inventor		Signature	<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Anne M. Kornbau Typed or Printed Name	<input checked="" type="checkbox"/>	attorney of record. Registration number 25,884	202-628-5197 Telephone number	<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	August 7, 2008 Date
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<input checked="" type="checkbox"/> *Total of 1 _____ forms are submitted.																

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

ATTY.'S DOCKET: FUJIWARA=4

In re Application of:	)	Confirmation No.: 5657
	)	
Makoto FUJIWARA et al	)	Art Unit: 1621
	)	
Appln. No.: 10/564,039	)	Examiner: Nizals CHANDRAKUMAR
	)	
Filing Date: January 10, 2006	)	August 7, 2008
	)	
For: AMINE COMPOUND AND USES)	)	
THEREOF	)	

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Customer Window, Mail Stop  
Honorable Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building, Mail Stop AF  
401 Dulany Street  
Alexandria, VA 22314

Sir:

Replying to the Advisory Action mailed July 22, 2008, please enter the following request for a pre-appeal brief conference.

According to the Advisory Action, the amendment filed July 1, 2008, will be entered for purposes of appeal

The only claim remaining in the present application is claim 1,

Claim 1 has been rejected under 35 U.S.C. 112, first paragraph, for lack of support in the specification for the claims.

It is respectfully submitted that there is sufficient enablement in the specification for claim 1 as amended in the amendment filed July 1, 2008. The claimed amine compound is now limited to compounds having the recited absorption maximum, molecular absorption coefficient, fluorescence maximum, decomposition point, and glass transition point.

Moreover, claim 1 also defines the claimed compounds by their method of preparation, as disclosed at pages 45-49, Examples 1-4. One skilled in the art, without undue experimentation, can readily determine what amine compounds that have a moiety as described by General formula 1 possess the properties recited in claim 1.

Many Federal Circuit decisions have confirmed that “*ipsis verbis*” disclosure is not required to satisfy the written description requirement. As the Federal Circuit stated in *Union Oil of California v. Atlantic Richfield Co.*, 208 F.3d 989, 987; 54 USPQ2d 1227m 1232 (Fed. Cir. 2000), “The written description requirement does not require the applicant ‘to describe exactly the subject matter claims, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.’”; “the written description requirement does not require identical descriptions of claimed compounds, but it requires enough disclosure in the patent to show one of skill in this art that the inventor ‘invented’ what is claimed.” In the present application, the compounds have been described by chemical formulae and properties. ‘One skilled in the art can readily ascertain what is the invention covered by claim 1.

It is respectfully submitted that claim 1 is not obvious under 35 U.S.C. 103 (a) over Bader et al. and Yoshio et al. The Examiner's position is that because the component parts are known in Bader and Yoshio, and the only difference is the combination of the elements of Bader and Yoshio into a single molecule. However, the Examiner has not demonstrated how or why one skilled in the art would combine the moieties of Bader and Yoshio to obtain the particular compounds claimed herein. The Examiner conceded that Bader does not teach chromenone-tripheynylamine combinations such as compound A claimed herein, and Yoshio only teaches chromenones B with substituents on the rings or charge transfer substances.

It is respectfully submitted that one cannot predict with any degree of certainty if combining previously disclosed moieties will result in a useful compound, as chemical compounds have wildly unpredictable properties. The Federal Circuit in *Eli Lilly & Co., v Zenith Goldline Pharmaceuticals, Inc.*, 2001 WL 139704, 5 S.D. Indl, 2001, aff'd 471 F.3d 1369; 2006 U.S. App. LEXIS 31748; 81 U.S.P.Q.2D (BNA) 1324, December 26, 2006, Decided, Rehearing denied by, Rehearing, en banc, denied by Eli Lilly & Co. v. Zenith Goldline Pharms., Inc., 2007 U.S. App. LEXIS 8750 (Fed. Cir., Mar. 29, 2007)US Supreme Court certiorari denied by Dr. Reddy's Labs., Ltd. v. Eli Lilly & Co., 2007 U.S. LEXIS 9133 (U.S., Oct. 1, 2007)US Supreme Court certiorari denied by Teva Pharms. USA, Inc. v. Eli Lilly & Co., 2007 U.S. LEXIS 10992 (U.S., Oct. 1, 2007), quoted Treatise: "In deciding obviousness under 103(a), the focus is not on the ability of chemists to imagine a compound, nor on their ability to synthesize a molecule to order, but on

whether the prior art provided apparent reason or motivation to take the steps that led to synthesis of the new compound. “

In the present case, the Examiner has given no motivation for preparing compounds as claimed herein, but has only demonstrated that the prior art shows each moiety of the claimed compounds. There is nothing in either Bader or Yoshio that would lead one skilled in the art to predict that the compounds claimed herein would have the properties claimed herein.

In view of the above, it is respectfully requested that the rejection of claim 1 be reversed and that claim 1 be allowed.

Respectfully submitted,

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Attorneys for Applicant

By 

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